

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MeUndies, Inc.

Petitioner,

v.

Drew Massey dba myUndies Inc.

Registrant

Mark: MYUNDIES

Cancellation. No. 92055585

# 77597995

**PETITIONER'S REPLY BRIEF IN CROSS-MOTION  
FOR SUMMARY JUDGMENT, AND MOTION TO STRIKE**

Registrant filed a Reply/Response in support of its Motion to Dismiss and in opposition to Petitioner's Cross-Motion for Summary Judgment, in which Registrant has included a wealth of unsupported scandalous, irrelevant allegations about Petitioner and Petitioner's Counsel but a paucity of compelling facts in support of its position. Registrant has failed to carry the burden to prevail in its Motion to Dismiss, and has failed to rebut with evidence the Petitioner's Motion for Summary Judgment. Merely restating the unsupported conclusory statements of its initial Motion does not constitute evidence that the '473 Reg. is not void *ab initio*, or that the subject mark has not been abandoned. In fact, the tone of Registrant's response only emphasizes that Registrant is incapable of rebutting the facts and arguments that Petitioner has advanced to establish that the registration is invalid. Therefore, the '473 Reg. should be cancelled so that that it will be removed as a bar to registration of Petitioner's mark.

**A. MOTION TO STRIKE MATTER FROM REGISTRANT'S PLEADING**

Pursuant to TBMP Rule 506.01 and Fed.R.Civ.P. 12(f), Petitioner hereby moves to have the Board strike Registrant's Response pleading in its entirety, as it is a testimonial document and thus formally deficient. At a minimum, Petitioner requests that the Board strike from Registrant's pleadings all references to Petitioner's alleged "stealing", "fraud", and other



07-16-2012

redundant, immaterial, impertinent and scandalous matter therein. Furthermore, the form of the pleading itself is testimonial and thus inappropriate, and should thus be stricken.

The materials sought to be stricken, as set forth below, have no bearing on the issues in the case, nor are they pertinent to the Motions currently before the Board in the case. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571-1572 (TTAB 1988) (immaterial allegation stricken). Petitioner moves to strike from the pleadings the following allegations:

1. "Petitioner's Cancellation request is ... based on fraud." Scandalous, impertinent and unsupported by evidence.
2. "Petitioner has attempted to steal a legal trademark." Scandalous, impertinent and unsupported by evidence.
3. "Petitioner is... making false allegations, fabricated testimony and... filing a fraudulent cancellation petition." Scandalous, impertinent and unsupported by evidence.
4. "The USPTO Board should not allow the continued unethical legal activity by the Petitioner's counsel...." Scandalous, defamatory, impertinent and unsupported by evidence.
5. Petitioner moves to strike the portion of Numbered Paragraph 2, "Similar to public company Zynga... via facebook.com." as immaterial and nonresponsive.
6. Petitioner moves to strike everything in Numbered Paragraph 3 after the word "Deny" as immaterial, as it describes only services "in development" and in "beta" (pre-market) state, not services actually in use.
7. Petitioner moves to strike Numbered Paragraph 4 as immaterial. In the absence of Registrant's denial of the allegations to which Registrant purports to respond in Paragraph 4, Petitioner moves that Registrant's response should be deemed admitted, namely, that Registrant has abandoned and is no longer the owner of the URL MYUNDIES.COM, which is featured in its specimens of use in the '473 Reg. file history in support of use in commerce.
8. Petitioner moves to strike everything in Numbered Paragraph 5 after the word "Deny" as impertinent and immaterial. Registrant's original specimen photograph shows the URL "MYUNDIES.COM" on the hangtag attached to the garment, in matching typeface to the pictured garment sample. Petitioner has not claimed nor has Petitioner made "a false assumption" that "the URL is maniaTV.com".

9. Petitioner moves to strike everything in Numbered Paragraph 6 after the word "Deny" as impertinent, scandalous, defamatory and immaterial.
10. Petitioner moves to strike the remainder of the pleading as impertinent and inappropriate, as it comprises testimony by Registrant in a form not suited to pleadings nor to a Memorandum in support of a Motion. As such, it is impossible to formulate a proper response to the argument, such as it is.

In the event that the Board does not grant the motion to strike all or any portions of Registrant's Response pleading, Petitioner hereby submits its Reply to Registrant's Response brief.

**B. SUBSTANTIVE REPLY TO REGISTRANT'S OPPOSITION TO MOTION FOR SUMMARY JUDGMENT**

Petitioner has demonstrated in its pleadings and the Motion for Summary Judgment that Registrant's use of the mark is at best token, and has not supported the initial grant of registration nor the continuing registration in good standing of the MYUNDIES mark. Respondent has, through its lack of evidence of more than single-piece token use, and its admitted abandonment of the MYUNDIES.COM domain name to a third-party whom it is allowing without authorization to compete directly in the field of undergarment sales and distribution, failed to take any action to contradict the accuracy or probative value of Petitioner's showing. *Playboy Enterprises Int'l, Inc. v. Diane Dickson dba Bunny*, Cancellation No. 92047717 (T.T.A.B. July 18, 2006). The Registrant claims that based on the "facts" in its pleadings, the cancellation proceedings should be dismissed. However, Registrant has not set forth any facts, only unsubstantiated conclusions and wild conjecture. Registrant has failed to demonstrate its legitimate use of the subject mark of the '473 Reg., and has only succeeded in dirtying its hands in the process of obfuscation and manufacturing of evidence to hastily build a hollow claim of use in response to Petitioner's filing of the instant Petition. Such conduct should not be rewarded by the Board, especially in light of the Registrant's absence of documented use or evidence thereof since before the grant of registration, and the evidence of Registrant's evidence to abandon the mark, most notably by allowing its MYUNDIES.COM domain name to expire and fall into the hands of a third-party who has been using the domain name to promote and sell directly competitive retail services in the field of underwear and apparel covered by the '473 Reg.

Even taking their testimonial nature at face value, Registrant's pleadings and proffered evidence have conclusively failed to rebut Petitioner's evidence that (a) the '473 Reg. is void *ab initio*, and (b) the subject mark was abandoned by Registrant.

1. Registrant's Facebook.com Retail Store Was Hastily Assembled in Response to the Petition to Cancel and is Not Valid Evidence of Use Sufficient to Rebut the Claim of Abandonment.

According to Registrant, it operates a retail web site at "facebook.com/myundies" where goods are purportedly available for purchase. It has provided no evidence of said retail operation other than listing the foregoing domain name. It has not provided any evidence of actual sales or shipments of goods that might support its claim that the mark is in use. Instead, to cover up this glaring omission, Registrant mentions the irrelevant market capitalization of an Internet start-up and refers to a "shopping mall on Facebook by payment [sic]" to provide the impression of commercial activity where there is none.

Registrant's Facebook retail page was created in May 2012, one week after the instant proceeding was initiated. Second Sapphire Decl. 2. Registrant created the account on the day that it filed the Answer / Motion to Dismiss in this action. *Id.* None of the content accessible through the "Facebook.com/myundies" address was accessible prior to the creation date, since the page had not yet been created. In light of the foregoing, Registrant's claim that it has been using the MYUNDIES mark commercially in connection with the sale of garments rings hollow, since said use was clearly ginned up in response to the Petition to Cancel. Likewise, Registrant created the "twitter.com/MYUNDIES" account to which it refers in its Response on or around May 9, 2012, obviating the legitimacy of its claims that its marketing efforts have been ongoing, and not merely hastily constructed in response to the instant Petition.

2. Registrant's Beta and Developmental-Stage Applications Do Not Support a Finding of Commercial Use Sufficient to Support the Registration of the MYUNDIES Mark.

Registrant argues that it "does have additional commercial/mobile Apps in development" and offers the previously attached retail "app" image as a "preview" of a "beta web site" whose cover page images "will constantly change". What Registrant does not, has not and cannot argue with supporting evidence, is that it has been selling or shipping all or any of the subject goods at

any time since it filed its Allegation of Use until it hastily opened the Facebook.com store in response to the instant Petition. The existence of plans, even assuming such plans are more than the single image produced by Registrant, is not actual use. *Jonathan M. Kelly v CityStay Hotels, LLC*, Cancellation No. 92048998 (T.T.A.B. April 8, 2010) (Registration cancelled and application found void *ab initio* because without actual use, "[i]t is not enough that respondent contracted with third-parties to create a web site and build technology and booking servers, or even that applicant advertised and promoted [its services] under the [subject mark]."). Registrant admits that the described developmental "uses" of the mark are all prospective and not yet commercially viable. They do not prove commercial use sufficient to support registration. More significantly, the admitted fact that Registrant's sales operation is "in development" demonstrates that the '473 Reg. was improperly granted for a mark not in use sufficient to satisfy the requirements of federal trademark registration. The '473 Reg. is therefore void *ab initio* and should be cancelled. *Cf. Parametric Technology Corp. v. PLMIC, LLC*, Opposition No. 91177168 (T.T.A.B. February 12, 2010) (Applicant's unsuccessful attempt to sell its services to a single potential services did not constitute rendering of its identified services at the time of filing its use-based application, thus application was declared void *ab initio* and Opposition was sustained.)

3. To Support its Continuing Registration of the Mark, Registrant Has To Date Only Produced Evidence of One Pair of Boxer Shorts and a Forum Comment from 2000 Referencing a Domain Name it No Longer Owns.

- a. Registrant Has Not Demonstrated Use of the Mark In a More Than Token Manner, Which Does Not Support Federal Registration.

Registrant has failed to produce any evidence of use of the subject mark of the '473 Reg. on more than a single garment, and for that reason the Registration is void *ab initio*, or, in the alternative, has been abandoned, and in either case should be cancelled. Registrant claims that it has "thousands of produced product with trademark" [sic]. It alleges that "if needed, additional pictures can be provided", however, it has made no effort to provide evidence. In fact, Registrant produced one additional Exhibit in its responsive pleading, namely, another photograph of the same beige boxer shorts used in the original 2009 specimen and earlier Exhibits, with the same

hangtag, pulled out from behind the waistband and showing "freemyundies.com". Nothing indicates that this is a different garment; in fact, it is photographed on the same surface as in the other photographs, indicating that the photos were all taken at the same time, of a single specimen. Self-serving conclusory statements about "experienced apparel manufacturers" do not count as evidence, nor do unsubstantiated assertions like the foregoing alleging the thousands of products produced by Registrant. In *Bionorica AG v. TechWorld Corporation, Inc.*, the owner of an application filed under Section 1(a) was found to have placed the mark on a nasal care product and offered it for sale. Opposition No. 91186641, July 8, 2010, at 9. However, there was no evidence that the goods were sold or transported, pursuant to Section 45 of the Trademark Act. *Id.*, 10. The opposer's motion for summary judgment as to the non-use of the mark prior to the filing date of applicant's Section 1(a) application was sustained because applicant failed to rebut it. *Id.* The same result should pertain here.

b. Registrant's Abandonment of MYUNDIES.COM Acts as Proof of its Abandonment of the MYUNDIES Mark.

Registrant's MYUNDIES.COM domain name was sufficiently important to the business in 2009 that a specimen of use featuring the URL was used in support of the Statement of Use filed in the application, and its subsequent abandonment demonstrates that Registrant was no longer committed to maintaining the MYUNDIES trademark. Registrant has not explained why its principal domain name -- indeed, its d/b/a entity name! -- was not renewed and was allowed to expire. After filing a specimen featuring the "MYUNDIES.COM" domain name (with no mention of any other "myundies" URLs) to promote the sale of the subject goods in support of its claim of use in commerce, Registrant cannot now claim that "MYUNDIES.COM" is just a run-of-the-mill insignificant domain name and other, less-immediate URLs like those Registrant listed in its Response are somehow more commercially viable to promote the MYUNDIES mark; to do so would strain credulity beyond the breaking point.

For an entity whose trademark and purported business model was tied in with a signature/marquee URL to allow that URL to expire indicates that the trademark and/or the business was no longer a going concern. In fact, Petitioner's pre-filing investigation did not reveal any use by Registrant of the MYUNDIES mark, instead revealing use of the URL and mark by the third-

party domain name registrant Marchex, whose page offering links to underwear and apparel retailers at the MYUNDIES.COM domain name continues to date, in direct competition with the subject mark and goods of Registrant's '473 Reg. *See* Sapphire Decl. (First), Para. 5. Rather than deal with the fact that it has abandoned and thus failed to maintain the registration of its key domain name, allowing it to thus fall into the hands of an alleged domain name aggregator, Registrant instead offered up a lame hodge-podge of whiffling excuses about its prospective "plans" for "leveraging several URLs" and other irrelevancies.

Registrant cannot even claim that it has sought to reclaim the abandoned URL through an ICANN domain dispute, since it clearly has not done so. The fact that it has not sought to stop the registrant of the MYUNDIES.COM domain name from promoting and selling underwear and other apparel through a web site located at the URL indicates that Registrant abandoned the mark long before the instant Petition was filed.

4. Registrant's Clamorous Efforts to Create the Appearance of Legitimate Use Are Being Pursued Solely In Order to Extort a Settlement From Petitioner.

As evidenced in the pleadings and supporting Declarations in this proceeding, Registrant is incapable of demonstrating that its Registration is legitimate. The fact that it has shown only a single garment -- the same garment photographed in the same setting in the original 2009 specimen of use and Exhibits to its pleadings -- only proves Petitioner's claims that the Registration is void *ab initio* and should thus be cancelled. Likewise, the fact that Petitioner has abandoned and allowed to expire the domain name used in its allegedly Statement of Use - era and earlier promotions, and then allowed the subsequent owner to use the URL in connection with an unauthorized third-party "MYUNDIES"-branded web page offering goods in direct competition with Registrant proves that Registrant intended to abandon its MYUNDIES mark, and that the mark was abandoned until after the instant Petition was filed and Registrant perceived a potential opportunity to extort a monetary settlement from Petitioner.

On May 14, 2012, after it had ample time to review the Petition to Cancel and Petitioner's application file history, Registrant contacted Petitioner's counsel of record with a "Demand Notice" via email. Asserting alleged but unspecified rights in the "tradename and mark MYUNDIES", Registrant threatened to file a civil suit that would "be costly for [Petitioner] and

most likely will result in the closing of [Petitioner's] business entirely". Registrant further threatened that it would "caus[e] all potential future investors not to invest" and give Petitioner and its investors "a major PR blackeye". Wasting little time getting to the point, Registrant demanded Petitioner "pay[] \$25,000 in [Registrant's] legal costs (as directly billed by counsel)", continuing with the threat that if Petitioner failed to pay up, "it will be fatal. As you well know."

Thus, after no fewer than three years of inactivity and the abandonment of key intellectual property assets in connection with the subject mark of the '473 Reg., including the MYUNDIES.COM domain name featured in Registrant's aged promotional materials, and allowing the latter domain name to be registered and operated by a direct competitor, effectively destroying the distinctiveness of the MYUNDIES mark as a source-identifier, Registrant saw that it might be able to salvage a payday out of the Petition to Cancel its phantom mark filed by Petitioner, and created the narrative in its pleadings, including the hastily-assembled Facebook and Twitter pages, in furtherance of its extortion plans. These purported uses should be seen for what they are: untimely and unseemly efforts by a desperate Registrant to salvage value from a mark associated with a failed venture that had been abandoned years before but whose associated trademark registration remained extant pending the six-year anniversary of registration, whereupon it likely would have been allowed to expire, just like the MYUNDIES.COM domain name before it. To allow the Registrant to maintain its registration in light of the evidence and arguments before the Board in this Motion would be an unfair outcome that would reward the improper registration and use of a phantom mark.

### **C. CONCLUSION**

In light of the foregoing and the earlier pleadings and evidence, Registrant's Motion to Dismiss is plainly without merit Petitioner respectfully requests the Motion to Dismiss thus be denied.

Registrant's evidence does not support the continued registration of the MYUNDIES mark, and the '473 Reg. should thus be cancelled. Registrant has failed to produce evidence that the mark is in use in any more than the most base token manner, or that it has ever been in use during the period of registration except as hastily cobbled together in response to the instant

4. On May 14, 2012, I received a "Demand Notice" email from Registrant threatening legal action against Petitioner in the absence of the immediate payment of \$25,000.00 to Registrant. Registrant's dishonest allegations therein were so hyperbolic that I counseled my client to ignore the demand pending the outcome of the instant proceeding, since in order to have enforceable rights which had not yet been borne out in any of our investigative efforts to find use by Registrant, Registrant would have to demonstrate valid commercial use and non-abandonment of the subject mark of the '473 Reg. Based on our extensive pre-filing investigation, as described in my earlier Declaration, we did not believe that Registrant could support the continued registration of the MYUNDIES mark. None of the evidence or allegations I have seen to date in these proceedings changes my assessment that Registrant's mark is subject to cancellation. A true and correct copy of the "Demand Notice" email message from Registrant is attached hereto as Exhibit "C".
5. Noah Taubman is an employee of Petitioner. Mr. Taubman is not employed by Petitioner's counsel. Because our pre-filing investigations had not revealed any use of MYUNDIES on the Internet or at retail, upon receipt of the first Office Action in Petitioner's Application, wherein the '473 Reg. was cited, Petitioner had Mr. Taubman attempt to contact Registrant to determine whether the mark was in use and the scope of any use. After he spoke with Registrant, Mr. Taubman reported that he had been told the mark is not currently in use.
6. The undersigned hereby declares and states that the facts set forth in this Declaration are true; that all statements made herein of the undersigned's own knowledge are true; that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

Dated: July 5, 2012

By:



Victor K. Sapphire, Esq.  
Connolly Bove Lodge & Hutz LLP  
333 S Grand Avenue, Suite 2300  
Los Angeles CA 90071  
(213) 787-2523

EXHIBIT  
"A"

(1) MyUNDIES

(1) MyUNDIES

facebook.com https://www.facebook.com/myUNDIES

facebook

Search for people, places and things



MyUNDIES Timeline 2012 Highlights

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+ Create a Page



Joined Facebook

May 9

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June

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EXHIBIT  
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myUNDIES (myUNDIES) on Twitter

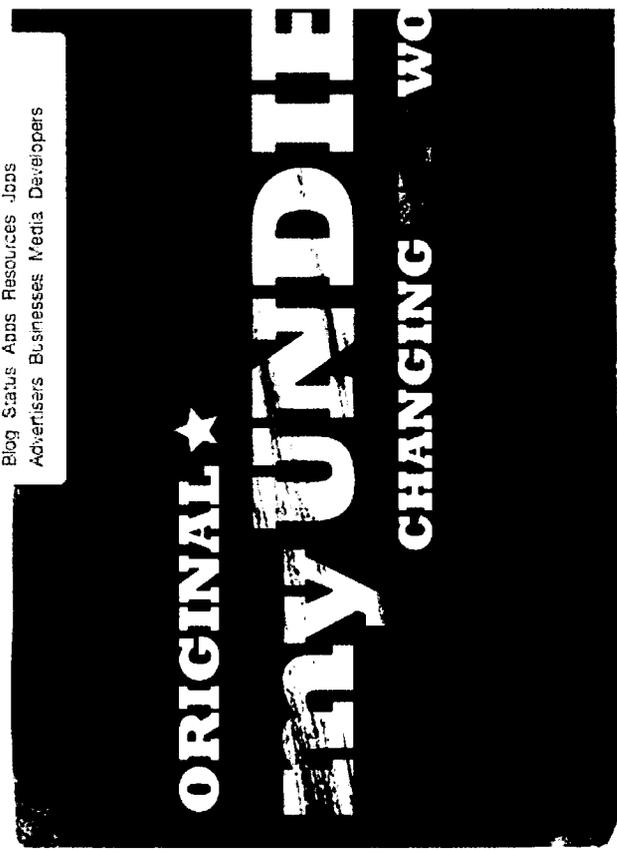
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**Victor Sapphire**

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**From:** drew massey [massey@masseyventures.com]  
**Sent:** Monday, May 14, 2012 7:51 AM  
**To:** Victor Sapphire  
**Subject:** DEMAND NOTICE

Victor,

As you know, your client MEUNDIES has infringed on our tradename and mark MYUNDIES. As well as our strategic business model. The USPTO has upheld this fact and denied your trademark application explicitly detailing how it is nearly identical (only one letter difference) and causes extraordinary confusion.

Our next course of action will be a civil suit that will include recovering damages from your client as well as its board and investors. The damages and recovered legal fees will be costly for your client and most likely will result in the closing of their business entirely (and, at minimum, causing all potential future investors to not invest). As well as a being a major PR blackeye for the company and its backers who have all knowingly attempted to steal and infringe on our rights.

Our settlement offer is fair and simple: You immediately withdraw (and forever cease) your cancellation claim on our legal and live trademark, your client changes their name to a mutually agreed upon name that is not conflicting in any way whatsoever (as they can probably spin in a positive way), and your client pays \$25,000 in our legal costs (as directly billed by counsel).

→ We are not fans of legal action, but are dumbfounded by your client and its backer's clear and direct attempts to infringe on our mark and cause us irreparable damages. We are attempting to be amicable, but will fully enforce our legal rights and will prevail. Do not be mistaken, for a startup like your client it will be fatal. As you well know. Conversely, as a young company they still have a fighting chance if they comply now. We therefore strongly urge you to advise your client to comply with our very fair offer. Once the cancellation is dismissed the litigator will be leading the efforts and our terms will not be so friendly.

Respectfully,

Drew

--

Drew Massey  
**Massey Ventures LLC:** Chairman  
[Massey@MasseyVentures.com](mailto:Massey@MasseyVentures.com)  
917.312.5032

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the PETITIONER'S REPLY BRIEF IN CROSS MOTION FOR SUMMARY JUDGMENT, AND MOTION TO STRIKE, and the accompanying SECOND DECLARATION OF VICTOR SAPHIRE and Exhibits thereto were served upon the Registrant by First Class Mail, postage prepaid, this 9th day of July, 2012:

Drew Massey dba Myundies Inc  
3387 Xanthia Street  
Denver, Colorado 80238

A handwritten signature in black ink, appearing to read 'Victor K. Sapphire', written over a horizontal line.

Victor K. Sapphire